

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	: O'DONNELL ET AL.	Confirmation No.	: 5408
Application No.	: 09/245,798	Group Art Unit	: 3623
Filing Date	: FEBRUARY 5, 1999	Examiner	: BOSWELL, B. V.
Docket No.	: 1690-001-01	Customer No.	: 00996
Title	: AUTOMATED LICENSING AND DELIVERY OF COPIES OF WORKS OF AUTHORSHIP, WITH PROOF OF LICENSE		

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

CORRECTED APPEAL BRIEF
37 CFR §41.37

Sir:

In response to the Notice of Non-Compliant Appeal Brief mailed January 27, 2009, Applicants hereby submit a Corrected Appeal Brief. A two-month extension of time up to and including April 27, 2009, is requested. Applicants claim small entity status. See 37 CFR §1.27. The Commissioner is hereby authorized to charge the requisite extension fee in the amount of \$245.00, any deficiency of fees submitted herewith, or credit any overpayment, to Deposit Account No. 07-1897.

37 CFR §1.8
CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system, EFS-Web, addressed to the Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450 on the date indicated below.

/Rosanne F. Chow/
Rosanne F. Chow

April 27, 2009
Date

Real Party in Interest:

The inventor, Mike O'Donnell, and an assignee US corporation of which he is an owner, iCopyright, Inc., which makes and uses in the US, and licenses others to make and use, embodiments of the invention.

Related Appeals and Interferences:

None.

Status of Claims:

Claims 126-147 stand rejected. Applicants hereby appeal the Examiner's rejections of claims 126-147.

Status of Amendments:

No amendment has been filed after the final rejection.

Summary of Claimed Subject Matter:

Each independent claim is separately addressed.

Claim 129 specifies:

A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, acknowledging acceptances without intermediate human activity, and publishing on a publicly accessible network records of licenses granted, comprising:

(a) presenting on a publicly accessible computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance has been received and acknowledged; and

(f) storing a record of the accepted license and making the record available for look-up by anyone from any computer on the publicly accessible network.

Support for claim 129 in the Specification (emphasis added):

At Page 1, Line 8

BACKGROUND OF THE INVENTION

"This invention addresses the problem of how to obtain licensing permission to use material created by another and how to present assurances that permission was obtained for the use."

At Page 1, Line 30

"The Internet has presented serious challenges to the established copyright clearance systems. Many forms of works of authorship are now published digitally on the Internet, including text, audiowave recordings, digital music specifications, still images, and videos. When these works of authorship are received by a client computer on the Internet, a copy can very easily be made on the client computer. The copy can then be reproduced, distributed, performed, displayed, or used to prepare a derivative work. Although it is very easy to make such uses of source works of authorship, it is very difficult to find the owners of copyrights in these works or

their agents and obtain licenses. Furthermore, even if the source work of authorship is used with permission, it is difficult for a person viewing the reproduced work, including the owner of copyrights in the source, to verify that the source was, in fact, used with permission without exceeding the scope of the license.

"Inventors have attempted to solve this problem by presenting technical means to prevent or discourage unauthorized use of works of authorship. These methods include using public key encryption to verify certificates of authority which are attached to works of authorship to prove that licenses have been obtained. They also include various methods of applying watermarks to a digital work of authorship to trace the reuse of a work."

SUMMARY OF THE INVENTION

"Rather than presenting technical barriers to unauthorized use or providing means to discover or prove unauthorized use, this invention makes it much easier to obtain licenses (or "clearances") to use source material and to verify that the material has been used within the scope of the license. While some users will pirate materials given the opportunity, the vast majority will obtain a proper license if it can be done quickly and easily and they can easily prove to others that they obtained the proper license."

At Page 3, Line 13

"In another aspect, the invention is a method for granting licenses to use a work of authorship and publishing records of licenses granted...The server of the licensing web page then automatically creates a license record associated with the license that has been granted. The license record is given a unique license identifier which can be used to find the license record on the network. The unique license identifier is then transmitted to the licensee for presentation with each licensed use of the source work of authorship. When the licensee publishes or otherwise uses the source material, the licensee presents the unique license identifier so that each recipient of the material can use the unique license identifier to access on the network the license record and determine the scope of the license that was granted."

At Page 4, Line 25

"When the licensee publishes or otherwise uses the source content, the licensee places an ICL tag on the licensee's material. Like the PRC tag, the ICL tag is embedded in both machine readable form and human readable form. Selecting a hotspot associated with the machine readable tag will direct a user's web browser to the license data record where the license information can be verified. The human readable ICL tag can be used to manually find the license data record by typing it into a browser."

Claim 145 specifies:

A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, acknowledges acceptances without intermediate human activity, and publishes on a publicly accessible network records of licenses granted, comprising:

(a) a registration web page server component that presents on a publicly accessible computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presents to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) an acceptance receiver component that receives from the third computer on the network a message indicating acceptance of the offered terms and responds to the third computer with a message that the acceptance has been received and acknowledged; and

(f) a proof of license web page server component that store a record of the accepted license and makes the record available for look-up by anyone from any computer on the publicly accessible network.

Support for claim 145 in the Specification (emphasis added):

At Page 1, Line 8

BACKGROUND OF THE INVENTION

"This invention addresses the problem of how to obtain licensing permission to use material created by another and how to present assurances that permission was obtained for the use."

At Page 1, Line 30

"The Internet has presented serious challenges to the established copyright clearance systems. Many forms of works of authorship are now published digitally on the Internet, including text, audiowave recordings, digital music specifications, still images, and videos. When these works of authorship are received by a client computer on the Internet, a copy can very easily be made on the client computer. The copy can then be reproduced, distributed, performed, displayed, or used to prepare a derivative work. Although it is very easy to make such uses of source works of authorship, it is very difficult to find the owners of copyrights in these works or their agents and obtain licenses. Furthermore, even if the source work of authorship is used with permission, it is difficult for a person viewing the reproduced work, including the owner of copyrights in the source, to verify that the source was, in fact, used with permission without exceeding the scope of the license.

"Inventors have attempted to solve this problem by presenting technical means to prevent or discourage unauthorized use of works of authorship. These

methods include using public key encryption to verify certificates of authority which are attached to works of authorship to prove that licenses have been obtained. They also include various methods of applying watermarks to a digital work of authorship to trace the reuse of a work."

SUMMARY OF THE INVENTION

"Rather than presenting technical barriers to unauthorized use or providing means to discover or prove unauthorized use, this invention makes it much easier to obtain licenses (or "clearances") to use source material and to verify that the material has been used within the scope of the license. While some users will pirate materials given the opportunity, the vast majority will obtain a proper license if it can be done quickly and easily and they can easily prove to others that they obtained the proper license."

At Page 3, Line 13

"In another aspect, the invention is a method for granting licenses to use a work of authorship and publishing records of licenses granted...The server of the licensing web page then automatically creates a license record associated with the license that has been granted. The license record is given a unique license identifier which can be used to find the license record on the network. The unique license identifier is then transmitted to the licensee for presentation with each licensed use of the source work of authorship. When the licensee publishes or otherwise uses the source material, the licensee presents the unique license identifier so that each recipient of the material can use the unique license identifier to access on the network the license record and determine the scope of the license that was granted."

At Page 4, Line 25

"When the licensee publishes or otherwise uses the source content, the licensee places an ICL tag on the licensee's material. Like the PRC tag, the ICL tag is embedded in both machine readable form and human readable form. Selecting a hotspot associated with the machine readable tag will direct a user's web browser to the

license data record where the license information can be verified. The human readable ICL tag can be used to manually find the license data record by typing it into a browser."

Claim 126 specifies:

A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmitting a copy of a work, comprising:

(a) presenting on a computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responding to the third computer with a message that the acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms and request for an electronic copy, sending to the third computer via the network an electronic copy of the first work of authorship.

Support for claim 126 in the Specification (emphasis added):

At Page 6, Line 16

"When a user seeks clearance of a license to use a source work of authorship (an "article") the system also provides a service to the user by providing the article either in preferred electronic format or professionally printed and mailed. Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

"Publishers, identified in the publisher's file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

"Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87."

At Page 12, Line 4

"FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines

the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques.

Claim 128 specifies:

A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, printing a copy of a work, comprising:

(a) presenting, on a computer network, license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and requesting that a paper reprint be delivered, responding to the third computer with a message that the acceptance and request have been received and acknowledged, and

(f) after the message indicating acceptance and reprint request is received, as a consequence of having received the acceptance and request, the clearinghouse server system sending to a printer a copy of the work of authorship for printing on paper and delivery.

Support for claim 128 in the Specification (emphasis added):

At Page 6, Line 16

"When a user seeks clearance of a license to use a source work of authorship (an "article") the system also provides a service to the user by providing the article either in preferred electronic format or professionally printed and mailed. Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

"Publishers, identified in the publisher's file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

"Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87."

At Page 12, Line 4

"FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques."

Claim 138 specifies:

A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmits a copy of a work, comprising:

(a) a registration web page server component that presents on a public network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a

first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presents to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) an acceptance receiver and fulfillment component that receives from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responds to the third computer with a message that the acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms and the request, sends to the third computer via the network an electronic copy of the first work of authorship.

Support for claim 138 in the Specification (emphasis added):

At Page 6, Line 16

"When a user seeks clearance of a license to use a source work of authorship (an "article") the system also provides a service to the user by providing the article either in preferred electronic format or professionally printed and mailed. Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

"Publishers, identified in the publisher's file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in

an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

"Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87."

At Page 12, Line 4

"FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques."

Claim 142 specifies:

A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, and, in response

to acceptances, without intermediate human activity, prints a copy of a work for delivery to a licensee, comprising:

(a) a registration web page server component that presents on a public network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) an acceptance receiver and fulfillment component that receives from the third computer on the network a message indicating acceptance of the offered terms and a request for a paper reprint, responds to the third computer with a message that the acceptance and request have been received and acknowledged, and, after the message indicating acceptance is received and as a consequence of having received the acceptance, sends to a printer a copy of the work of authorship for printing on paper and delivery.

Support in the Specification for claim 142 (emphasis added):

At Page 6, Line 16

"When a user seeks clearance of a license to use a source work of authorship (an "article") the system also provides a service to the user by providing the

article either in preferred electronic format or professionally printed and mailed. Consequently, there is a link 71 between the publisher subsystem 61 and the clearance and fulfillment subsystem 63. The link allows articles from an articles file 72 or from the network accessed via a URL from an articles URL file 73 to be communicated to the clearance and fulfillment subsystem for transmission to a user as identified in a user file 74 or for transmission to a fulfillment provider as identified in a fulfillment providers file 75.

"Publishers, identified in the publisher's file 76, can upload articles to the articles file 72, or article URLs to the article URLs file 73, along with article rules stored in an article rules file 77 and business rules for the licensing of each article stored in a business rules file 78.

"Clearances may be sought by companies, which are identified in a companies file 81, as known via their contacts stored in the contacts file 82, or by users identified without companies stored in a users file 74. Their requests for clearances are stored in the clearance request file 83 and the granted clearances are stored in a clearances file 84. Similarly, fulfillments requested by users or companies are stored in a fulfillment request file 85 with details in a subfile 86. The fulfillment options which may be allowed for each granted clearance are stored in the fulfillment options file 87."

At Page 12, Line 4

"FIG. 6 shows the process followed by a user. When a user views on the Internet an item of content which is registered with the system 51 the user can click on a PRC tag 52 which directs the user's web browser to a page of the iCopyright website which is customized for that publisher and that content. At the website, the user enters a name and password at step 53. From here, the user can go to step 54 or directly to step 58. The user enters information about himself, step 54, his affiliation and intended use, step 55, and his payment information, step 56. The user then accepts or declines the terms and conditions at step 57, and proceeds to state his intended use at step 58. The user then views the license or a summary of the license, step 59, and accepts or declines the license. If the license is accepted, the user proceeds to step 91 and receives confirmation and specifies any special instructions that are required to fulfill the user's request. In the case of Professional Reprints or other specialized document

fulfillment requests, the user is fills out forms that collect the required job and document transmittal information. This could also include the use of special (publisher required or user requested) document packaging, encryption, digital watermarking or transmission techniques.

Grounds of Rejection to Be Reviewed on Appeal:

Claims 126-127, 129-131, 138, and 145 stand rejected under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.);

Claims 128, 142, and 146-147 stand rejected under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Elsevier Science (www.elsevier.com);

Claims 133 and 139 stand rejected under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of US 6,119,108 (Holmes et al.);

Claims 136-137 and 143-144 stand rejected under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Elsevier Science (www.elsevier.com) and in further view of US 6,119,108 (Holmes et al.); and

Claims 132, 134-135, and 140-141 stand rejected under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Digital Object Identifier (DOI) system.

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Argument:

Rejection of claims 126-127, 129-131, 138, and 145 under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.)

The issue for these claims is focused on whether a method or system with the last element is obvious. The last element is:

"making the record available for look-up by anyone from any computer on the publicly accessible network."

In the final office action, the Examiner asserts that this element is obvious because "Johnson et al discloses a publicly accessible network and storing a record of the accepted license and making the record available for look-up from a computer on the publicly accessible network". It is true that Johnson teaches making the record available for look up by persons with certain management authorization, but Johnson does not teach making it accessible "by anyone". Johnson explicitly teaches away from making it accessible by anyone.

The Examiner maintains that, because Johnson teaches "that potential licensees are allowed access to the system," it is therefore obvious that anyone might be allowed access to all the records of what licenses have been granted and to whom. This does not follow. Just because all people are allowed access to some parts of the system and only administrators are allowed access to the records of what licenses were granted and to whom, it is not obvious that ALL people should be allowed access to the records of WHAT LICENSES WERE GRANTED AND TO WHOM. Johnson teaches that only administrators should have access to these records.

All web sites that are accessible on a network have some components that are accessible to more people and some components that are accessible to fewer people. There is no web site where all components have the same degree of availability to all. These differences are generally established by adjusting "security settings." For example, for most web sites, only the site administrator or the host operator can delete files, and there are typically some files for the web site that even the site administrator can not delete and can not fully erase by writing over each spot on the

hard disk where the data was stored, this function being limited to the host operator. As a more relevant example for the present issue, the site administrator usually has the power to revise any data that is presented on the site and others usually have very limited power or no power to revise data that is presented on the site. It is also common that a site will allow the world to view certain data collected at the site and allow only the site administrator to view other data collected at the site, such as number of site visits or IP addresses of visitors.

In Johnson, only the site administrator is allowed to view records of who had obtained a license to use a work of authorship. This information is not made available to the general public. The question that the applicant and the Examiner are grappling with is whether making this information available to the general public is obvious. Although this change from the prior art can easily be made by a programmer, this does not answer the question of whether it was obvious to do so.

The body of the application quoted above articulates extensively that making this information available to the general public is non-obvious and is an important invention over the then prior art relating to controlling uses of copyright protected works of authorship.

As described in quoted sections of the application above, the invented method is a solution to the problem of easy unauthorized copying of works of authorship that is completely different from the prior art solutions to this problem. Johnson does not even attempt to address this problem. There is nothing in the prior art, especially not in Johnson, which suggests this solution to the problem or motivates this solution to the problem. The prior art solutions of technical copy restriction and watermarking and the like all teach away from this solution. In contrast to the prior art technical solutions, the invention exploits the fact that humans are social animals and care what other people think of them when their actions are published for anyone to check on.

There is no teaching in Johnson that provides a suggestion or motivation to make the change to the Johnson system suggested by the Examiner. The examiner points out that "potential licensees" are allowed to access certain data in the system. However, they are not allowed to access "a record of the accepted license" as specified

by the last element of claims 129 and 145. The fact that they are members of the general public and are allowed access to some data does not make it obvious that they should be allowed access to other data to which only administrators are allowed access as taught by Johnson.

Thus, the examiner has not made a prima facie case of obviousness. Independent method claim 129 and the corresponding system claim 145 should be allowed, along with the claims that depend from them.

Independent method claim 126 and its corresponding system form claim 138 are rejected under §103 as unpatentable over Johnson (US 5,991,876).

With respect to the point of novelty of claim 128, the Examiner is misreading Johnson. Johnson does not teach or suggest that a person could place an order for a "copy" of a work of authorship. The only deliverables for which a person might place an order, as taught by Johnson, are "rights". The "rights" that may be ordered in the system taught by Johnson are so intangible that they have no embodiments. There is no "copy" of any right that may be ordered. The "right" is actually a legal release by a copyright holder in favor of the person to whom the right is granted, so that the licensee can not be successfully sued by the copyright holder for infringement of copyrights, provided certain limitations on the "right" are followed.

Johnson makes clear that the only properties offered by the system are rights and not copies. In column 3, Johnson states: "A second enhancement is the inclusion of an order table to provide a dynamic log of right authorizations and denials." (Emphasis added) In column 8 lines 15 - 20 Johnson states "during the first year of the contract, rights are offered at a base fee During the second year of the contract, rights are offered at a base fee of"

Details of the ordering capabilities of the system are discussed in column 9 beginning at line 35 where Johnson states that the order table "provides a dynamic log of right authorizations and denials". At lines 45 - 48 Johnson states: "Order_right field 448 contains a reference or link to a right_instance field 410 of rights table 408. This link identifies the right ordered." (Emphasis added)

In column 10 at lines 42 - 45, Johnson states "User interface 700 includes a view of a constructive index card 702 to specify a particular right for which authorization is sought." (Emphasis added)

Applicant respectfully submits that the Examiner is repeatedly misreading Johnson. In particular, where the Examiner states on page 9: "See figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60", none of these passages, when read carefully, supports the Examiner's view. Each of these passages refers to a "right" and not a copy of a work of authorship.

Figure 7 does not teach that the system may offer, or a user may receive "a copy of the work of authorship". Figure 7 teaches that, when a prospective licensee requests a license, the licensee may be required to specify whether the type of use will be on paper or electronic and the number of copies that the licensee wishes to make. The fact that a user is requested to state what kind of use the user will make of the rights obtained does not imply that the server can send a copy of a work of authorship. Figure 7 does not teach that a user of the server system may place an order for a copy to be delivered, in any form, or that the server system is capable of delivering a copy in any form.

In column 7 at lines 1 - 10 Johnson states that the types of works for which copyrights might be licensed and managed by the system include works that may be embodied in electronic copies. However, Johnson says nothing about delivering electronic copies of those works to licensees.

In column 7 at lines 40 - 55, Johnson explains that the type of use for which a prospective licensee may seek permission may be specified, such as: educational, not for profit, commercial, on paper, in an optical memory, in a computer memory serving an intranet, or in a computer memory serving the internet. This paragraph in Johnson does not teach either that a prospective licensee can place an order for a copy of a work of authorship or that the system could be made capable of delivering a copy of a work of authorship.

In column 9 at lines 35 - 55, Johnson states that the right ordered might be the right to make electronic copies of the work. However, Johnson says nothing about allowing the licensee access to an electronic copy of the work to make these copies.

This paragraph of Johnson merely teaches that “rights” can be ordered, not that copies can be ordered or that the system has the ability to deliver the work upon acceptance of the license.

In column 10 at lines 40 - 60, Johnson discusses the user interface through which a prospective licensee will place an order for rights. When the prospective licensee places the order, the licensee may be required to specify whether the use will be made on paper or electronically and the number of copies that the user will make. This paragraph of Johnson does not teach either that the prospective licensee may place an order for copies or that the server system can deliver copies.

Thus, Johnson does not teach or suggest that a person could request or receive a “copy” of a work of authorship. Although each person in Johnson who orders a “right” relating to a work of authorship (in contrast to other kinds of property with which the system in Johnson is also designed to work) must have a copy of the work of authorship (or the original) to exercise that right, Johnson does not address how the person might get such a copy. Presumably, they already have a copy -- otherwise they would not know that they want a right to make copies or other copyright restricted uses of it. Element (e) of claim 126 specifies that a copy of the work of authorship is not provided across the network until after the user has accepted the terms of an offered license.

Even if one were to assume that a person who needs source materials to exercise the right they bought might, in some cases, be able download those materials from a site on the World Wide Web, Johnson does not suggest or imply that the materials might be delivered “as a consequence of” the person having indicated “acceptance of the offered terms and request for an electronic copy”. This is the crux of the matter.

The question then is whether it is obvious that the system of Johnson might be improved to add a feature that, once a customer buys a right to use materials by accessing a server across a network, the server will then offer a chance to request that a copy be sent across the network and, if the customer requests such a copy, it is automatically sent to the customer across the network.

Under US patent law, some improvements are patentable and some improvements are obvious and therefore not patentable. The Applicant submits that, if it were obvious to make the claimed improvement to the system of Johnson, it would have been done between the date the Johnson application was filed in 1996 and the date the present application was filed three years later. This is a field in which there was intense inventive activity during those years.

The Johnson patent application discloses inventions made by the Copyright Clearance Center (CCC). In 1996, when the Johnson application was filed, the CCC did not maintain a computer system for providing copies of works of authorship across the Internet to general public licensees. The CCC provided (and still provides) a service to publishers to help them grant licenses ("rights") to use their published works of authorship. The publishers published their works in various forms including electronic. Members of the public who saw or received a reference to one of those works could then go to the CCC to obtain a license to make a use of the work that was otherwise prohibited by copyright law. The licensees obtained their source materials directly or indirectly from the publishers, not from CCC.

Thus, neither the system then publicly disclosed by CCC nor the system taught by Johnson is sufficient to implement the invention. A link is required to a database that contains copies of the works of authorship in question. Such a link is not suggested by Johnson. The Johnson system does not store the work itself or even have a link with access to a database containing such works. A prospective licensee has to access the Johnson system and enter the title of the work or the author's name in order to locate the licensing rules for the work. If the prospective licensee decides to license the content based on the stated rules, they pay the administrator of the Johnson system. There is no stated mechanism for how a copy of the licensed content might be delivered to the licensee. The assumption is that the user already has a copy of the work and is simply paying for rights to copy it or otherwise do something with it other than merely read it. It is not obvious from Johnson to provide these functions because the repository only stores rights information about the work, it does not store the work itself.

To make a prima facie case that an improvement over Johnson is obvious, the Examiner must point to a teaching, suggestion, or motivation in the reference itself or in the knowledge generally available to one of ordinary skill in the art that the improvement should be made to the prior art system. The claimed concept may seem obvious now, but it was not obvious when the present patent application was filed in 1999, particularly for a system "usable by a plurality of publishers" as specified by element (a) of claim 126. Applicant submits that the present inventor was the first to invent the claimed method of automatically doing so upon request as part of a transaction to secure the rights and that this is a significant invention.

Claims 126 and 138 are therefore allowable.

Dependent claim 127 is allowable for at least the same reasons discussed above with regard to independent claim 126 from which claim 127 depends.

Dependent claims 130 and 131 are allowable for at least the same reasons discussed above with regard to independent claim 129 from which claims 130 and 131 depend.

Rejection of claims 128, 142, and 146-147 under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Elsevier Science (www.elsevier.com)

Claims 128 and 142 stand rejected under §103 as unpatentable over Johnson (US 5,991,876) in view of a reference (Elsevier) showing that a service of a human providing paper reprints of works of authorship in response to a request posted via a computer network was in the prior art. There are many such references that could be cited for this proposition.

The essential question is whether it was obvious to modify this service to be performed automatically, without human intermediation, and combine it with a server for granting reprint licenses such that the request for a license and the request for a paper copy could be submitted in a single session on the server and, as a consequence, an electronic copy of the work would then automatically be sent by the server system to a printer for printing on paper and delivery.

To address this question, Applicant begins by noting, as did the Examiner, that a combination of Johnson with the Elsevier service, or any similar service, would not produce the claimed invention because neither reference teaches that an electronic copy might automatically be sent to a printer without a link of human assistance.

In 1996 when the Johnson application was filed, the CCC did not maintain a computer system that was capable of sending copies of works of authorship to a printer for printing reprints. Thus, neither the system then used by CCC nor the system taught by Johnson is sufficient to implement the invention. In addition, a link is required to a database that contains printable copies of the works of authorship in question. Such a link is not suggested by Johnson or Elsevier.

The Examiner asserts that Johnson teaches "the third computer/client requests the order of paper copies be supplied," citing figure 7, column 7 lines 40 - 55, column 8 lines 1 - 22, column 9 lines 35 - 55, and column 10 lines 40 - 60. This is not correct. All of these parts of Johnson have been discussed above with respect to this issue except for the column 8 reference.

In column 8 at lines 1 - 22 Johnson discusses the rights table which holds information about rights granted. Again, the granting of a right is not the delivery of a copy. It is not the delivery of anything. Although the price to be paid by the prospective licensee as discussed in this paragraph of Johnson may vary according to the number of copies that the licensee is authorized to make, this section of Johnson does not teach that the prospective licensee may place an order for someone else to make the copies or that the server system may provide copies.

The Examiner argues her reading of Johnson is supported by the fact that Johnson mentions that educational institutions make copies of documents to create course packets. This fact reported by Johnson does not support the Examiner's position. It does not suggest or teach that the clearinghouse server system should allow users to place orders for copies of works authorship or that the server system should deliver ordered copies of works of authorship.

Claims 128 and 142 are therefore allowable.

Dependent claim 146 is allowable for at least the same reasons discussed above with regard to claim 128 from which claim 146 depends.

Dependent claim 147 is allowable for at least the same reasons discussed above with regard to claim 142 from which claim 147 depends.

Rejection of claims 133 and 139 under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of US 6,119,108 (Holmes et al.)

Dependent claim 133 depends from independent claim 126 and is allowable for at least the same reasons discussed above with regard to claim 126.

Dependent claim 139 depends from independent claim 138 and is allowable for at least the same reasons discussed above with regard to claim 138.

Rejection of claims 136-137 and 143-144 under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Elsevier Science (www.elsevier.com) and in further view of US 6,119,108 (Holmes et al.)

Dependent claim 136 depends from independent claim 128 and is allowable for at least the same reasons discussed above with regard to claim 128.

Dependent claim 137 depends from claim 136 and accordingly is allowable for at least the same reasons as claim 136.

Dependent claim 143 depends from independent claim 142 and is allowable for at least the same reasons discussed above with regard to claim 142.

Dependent claim 144 depends from claim 143 and accordingly is allowable for at least the same reasons as claim 143.

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Rejection of claims 132, 134-135, and 140-141 under 35 USC §103(a) as being unpatentable over US 5,991,876 (Johnson et al.) in view of Digital Object Identifier (DOI) system

Dependent claim 132 depends from independent claim 129 and is allowable for at least the same reasons discussed above with regard to claim 129.

Dependent claim 134 depends from independent claim 126 and is allowable for at least the same reasons discussed above with regard to claim 126.

Dependent claim 135 depends from claim 134 and accordingly is allowable for at least the same reasons as claim 134.

Dependent claim 140 depends from independent claim 138 and is allowable for at least the same reasons discussed above with regard to claim 138.

Dependent claim 141 depends from claim 140 and accordingly is allowable for at least the same reasons as claim 140.

Respectfully submitted,

/Paul F. Rusyn/

Paul F. Rusyn
Registration No. 42,118

Appendices:

- Claims Appendix (9 pages)
- Evidence Appendix (2 pages)
 - Rule 131 Affidavit (8 pages)
- Related Proceedings Appendix (2 pages)

Customer No. 00996

Graybeal Jackson LLP
155 - 108th Avenue NE, Suite 350
Bellevue, Washington 98004-5973
Telephone: 425.455.5575
Facsimile: 425.455.1046

CLAIMS APPENDIX

A listing of the appealed claims is hereby provided pursuant to 37 CFR §41.37(c)(1)(viii):

1-125. (Cancelled)

126. A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmitting a copy of a work, comprising:

(a) presenting on a computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responding to the third computer with a message that the acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms and request for an electronic copy, sending to the third computer via the network an electronic copy of the first work of authorship.

127. The method of claim 126 wherein the electronic copy includes electronically coded text.

128. A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, printing a copy of a work, comprising:

(a) presenting, on a computer network, license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and requesting that a paper reprint be delivered, responding to the third computer with a message that the acceptance and request have been received and acknowledged, and

(f) after the message indicating acceptance and reprint request is received, as a consequence of having received the acceptance and request, the

clearinghouse server system sending to a printer a copy of the work of authorship for printing on paper and delivery.

129. A clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, acknowledging acceptances without intermediate human activity, and publishing on a publicly accessible network records of licenses granted, comprising:

(a) presenting on a publicly accessible computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance has been received and acknowledged; and

(f) storing a record of the accepted license and making the record available for look-up by anyone from any computer on the publicly accessible network.

130. The method of claim 129 wherein the step of presenting license offering registration web pages is performed in a first server in the server system and

the step of presenting to the third computer a licensing web page is performed in a second server in the server system.

131. The method of claim 129 wherein functions of the server system are distributed across a plurality of physical computers and at least one of the server system steps is performed in the first computer.

132. The method of claim 129 further comprising publishing from a server on the network the first work of authorship in which the identifier of the first work of authorship is embedded such that, when the first work of authorship is displayed on the third computer and a user of the third computer clicks on a hot spot in the work of authorship, the embedded identifier is used to form a network address that links the third computer to the license offering web page for the first work of authorship.

133. The method of claim 126 wherein the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

134. The method of claim 126 wherein the electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

135. The method of claim 134 wherein the electronic copy includes a hotspot that, when selected by a user when the electronic copy is displayed on a computer display, causes a browser program to send a retrieve request to the network address of the web page containing a message verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

136. The method of claim 128 wherein the copy sent to a printer includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

137. The method of claim 136 wherein the message includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

138. A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmits a copy of a work, comprising:

(a) a registration web page server component that presents on a public network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presents to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship; and

(e) an acceptance receiver and fulfillment component that receives from the third computer on the network a message indicating acceptance of the offered terms and a request for an electronic copy, responds to the third computer with a message that the acceptance and request have been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered

terms and the request, sends to the third computer via the network an electronic copy of the first work of authorship.

139. The system of claim 138 wherein the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

140. The system of claim 138 wherein the electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

141. The system of claim 140 wherein the electronic copy includes a hotspot that, when selected by a user when the electronic copy is displayed on a computer display, causes a browser program to send a retrieve request to the network address of the web page containing a message verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

142. A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, and, in response to acceptances, without intermediate human activity, prints a copy of a work for delivery to a licensee, comprising:

(a) a registration web page server component that presents on a public network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first

registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) an acceptance receiver and fulfillment component that receives from the third computer on the network a message indicating acceptance of the offered terms and a request for a paper reprint, responds to the third computer with a message that the acceptance and request have been received and acknowledged, and, after the message indicating acceptance is received and as a consequence of having received the acceptance, sends to a printer a copy of the work of authorship for printing on paper and delivery.

143. The system of claim 142 wherein the copy sent to a printer includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

144. The system of claim 143 wherein the message includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

145. A clearinghouse server system that receives from publishers of works of authorship offers of licenses, presents the offers to potential licensees, acknowledges acceptances without intermediate human activity, and publishes on a publicly accessible network records of licenses granted, comprising:

(a) a registration web page server component that presents on a publicly accessible computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work;

(b) a works registration component that receives on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher;

(c) a database component that stores on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship;

(d) a license query web page server component that receives from a third computer on the network the identifier of the first work of authorship and, in response, presents to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship;

(e) an acceptance receiver component that receives from the third computer on the network a message indicating acceptance of the offered terms and responds to the third computer with a message that the acceptance has been received and acknowledged; and

(f) a proof of license web page server component that store a record of the accepted license and makes the record available for look-up by anyone from any computer on the publicly accessible network.

146. The method of claim 128 wherein the copy sent to a printer includes a human readable message indicating a name of the publisher of the first work of authorship.

147. The system of claim 142 wherein the copy sent to a printer includes a human readable message indicating a name of the publisher of the first work of authorship.

EVIDENCE APPENDIX

A copy of the Declaration of Mike O'Donnell and Andrew Cameron is submitted herewith in accordance with 37 CFR §41.37(c)(1)(ix).

Declaratory evidence pursuant to 37 CFR §1.31 has been submitted in the instant application on April 28, 2004. The evidence was acknowledged and entered into the record by the Examiner per the nonfinal office action mailed July 12, 2004, paper no. 20040702 of the file wrapper.

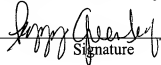


THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mike O'Donnell and Andrew Cameron
Title: AUTOMATED LICENSE OFFERING WITH EMBEDDED HOTSPOT (amended)
Serial No.: 09/245,798
Filing Date: February 5, 1999
Examiner/Unit: Beth Van Doren / 2700
Attorney Docket No.: 1690-1-1

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited in the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Fee Amendment, Commissioner for Patents, P O Box 1450 Alexandria, VA 22313-1450 on this 12th day of April, 2004.


Signature

Commissioner for Patents
P O Box 1450
Alexandria, VA 22313-1450

DECLARATIONS UNDER 37 CFR 1.131

1. My name is Mike O'Donnell. I am the lead inventor of the invention specified by claims 84 – 118 of the above-referenced pending U. S. patent application. My co-inventor, Andrew Cameron, contributed to some of the elements specified in dependent claims.

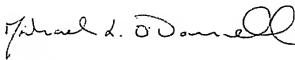
2. I conceived of all of the elements specified by the independent claims (84, 95, and 108) on a date at least as early as January 8, 1998. On that date, I authored a document detailing many aspects of the invented system, a copy of which is attached hereto as Exhibit A. The creation date of January 8, 1998 was automatically written into the electronic copies of the

document. The electronic record also shows that the document was printed on February 10, 1998. I gave copies of the document printed on February 10, 1998 to others for purposes of advancing the iCopyright business which was to be founded in part on the inventions specified by claims 84 – 118.

3. From January 8, 1998 through the filing date of the present application, February 5, 1999, I devoted fulltime working efforts to advancing the inventions specified by claims 84 – 118 and starting a business based on the inventions. When that business received venture funding I wrote the first draft of the specification for the present patent application that was filed February 5, 1999.

I declare that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true. I acknowledge that willful false statements and the like are punishable by fine or imprisonment or both and may jeopardize the validity of the application or any patent issuing thereon.

Dated the 24 day of April, 2004.

A handwritten signature in black ink, appearing to read "Michael D. O'Donnell". The signature is fluid and cursive, with the last name "O'Donnell" being more prominent and stylized.

Mike O'Donnell

4. My name is Andrew Cameron. I assisted Mike O'Donnell by fleshing out details of the inventions which he conceived. My contributions are specified in claims that depend from claim 84 in the present application. I did not contribute to the invention specified in claim 84.

I declare that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true. I acknowledge that willful false statements and the like are punishable by fine or imprisonment or both and may jeopardize the validity of the application or any patent issuing thereon.

Dated the 26th day of April, 2004.



Andrew Cameron

icopyright.com

Executive Summary

The Business

icopyright.com (<http://www.icopyright.com>) is the Internet's first electronic clearinghouse for proprietary content on the web. The business proposes to offer four distinct services that are not currently being offered by any other company:

1. icopyright.com will educate users of the Internet about the proprietary content available on the web, by raising the visibility of copyright issues where ever they surf.
2. icopyright.com will display the rights information and the acceptable use policy of each registered publisher and/or copyright owner and help to develop standardized policies for re-use of content.
3. icopyright.com will provide automated systems and forms for obtaining permission (clearance) to re-print, cite or re-purpose any content found on the web.
4. icopyright.com will deliver the content in a fashion stipulated by the publisher/owner, once permission has been granted and the status of the user has been verified. This may be in the form of printed copies or electronic media.
5. icopyright.com will provide secure, fully-enabled transaction processing for content licensing.

There are at least five sources of revenue for the icopyright service:

- Transaction processing fees on millions of clearances.
- Fees for delivery of paper re-prints and/or digital content.
- Advertising sponsorships.
- List capture and brokering of user names and web site owners.
- Licensing fees from software developers and content publishers for a software development kit (SDK).

The Mission

To place the icopyright icon  on every web page on the Internet.

The Business Opportunity

There currently does not exist a central clearinghouse for copyright permissions and clearance transactions for content found on the World Wide Web. Content owners and publishers want to protect their proprietary material. They want to be paid for re-prints and when their material is re-purposed in other ways. End users, particularly companies that are sensitive to the legal liabilities inherent in copyright infringement, need a standardized mechanism for obtaining permission and for paying any associated royalties for using content they find on the Internet.

President Clinton recently signed the "No Electronic Theft Act," which makes willful copyright infringement punishable by \$1,000 to \$100,000 and jail time, even if the offender does not make a profit on the infringed material. Even with tougher regulations, there remains a tremendous amount of confusion and misinformation about copyrighted information on the Internet.

icopyright has the opportunity to emerge as a centralized authority and clearinghouse for permissions and royalty clearances.

EXHIBIT A
Page 1 of 5

The Services

The service is envisioned to work as follows:

- The icrosoft icon is placed on participating web sites. This is a free service to content owners and publishers, so millions of companies that maintain web pages can be expected to participate.
- Each icrosoft icon is hotlinked via a unique URL to the icrosoft server database.
- When a user clicks on the icon, the icrosoft server detects which page the user is linking from and instantly displays the information pertinent to that content owner. This information may include the following:
 - The owner(s) of the copyrighted material.
 - The Terms of Use policy for different types of users. For example, content may be free to students, but not free to commercial enterprises.
 - The costs associated with re-prints or re-use of the content in various mediums.
 - The procedure for obtaining permission and/or buying the rights to use any of the content.
- An automated form that collects the necessary information from the user and forwards it to the appropriate permissions manager. The icrosoft clearinghouse may also have agreements with certain publishers to act as the permissions manager.
- The service will verify the user is who he or she says she is and that the content will only be used according to the terms of the licensing arrangement.
- Secure system for facilitating credit card payments.
- Upon content and payment clearance, automated follow up to the user to deliver the desired content.

Proprietary Features/Competitive Advantages

The business will be built on the following features and advantages:

- First to market. There is not room on any one web page or site for more than one button for copyright clearance. Content owners and publishers are likely to settle on one central clearinghouse service.
- Sophisticated web technologies, which include relational database and e-commerce systems.
- Relationships with large digital printing facilities to process re-print requests, and with digital mastering facilities (images, sound, video) to process content for re-use in electronic form (web, video, radio).
- Sophisticated payment, reporting, and auditing systems to ensure timely and accurate royalty payments to participating content owners and publishers.
- Possibility of exclusive contracts with large content owners/publishers like Time Warner, Disney, Playboy, ZDNet, CNET and other new media companies for all their Internet copyright clearance.
- Strong branding, supported by trademark protection of the icrosoft mark.

Market Size and Conditions

According to Network Wizards there are approximately 20 million web server hosts with a valid IP address. These servers host billions of web pages which are accessible by the general public worldwide, most of which contain copyrighted material. In addition, millions of domain names have been registered, growing at 100,000 new domain names each month. Seven new top level domain names are expected to come online this Spring. The number of people using the Internet is expected to grow from 40 million in 1998 to over 150 million by 2003.

A recent survey of copyright permissions on the Internet by Design Intelligence, uncovered the following information:

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- There is NO consistent policy or process to get content permissions from the Web.
- Some sites post a message that they will grant permission to use their content for personal and/or noncommercial use, but provide no clear way on how to go about it.
- The Wall Street Journal Interactive site advertises a number users can call to obtain reprints, but their is no automated, online mechanism for orders or payments.
- Netscape asks users to e-mail them to request permissions. Upon doing so, however, we never heard back.
- CNET asks users to e-mail them to request permissions. We received an e-mail back saying someone would be in touch. To date, no one has followed up.
- Disney provides no way for users to contact them regarding copyright clearances.
- ZDNET provides no way for users to contact them regarding copyright clearances.
- CNN provides no way to contact them regarding copyright clearances.
- ABC/NBC provides no way to contact them regarding copyright clearances.
- FOX doesn't have any legal notices about copyright and permissions.
- LA TIMES provides a phone number to call the LA Times Syndicate Permissions Desk for the proper permissions.
- NY TIMES provides an e-mail address and fax options to get reprints permissions, but no online forms mechanism.

Many sites do not include any copyright notices or Terms of Use pages. Those that do so present the information in small type at the bottom of the Homepage only. The conclusion from this preliminary research is that copyright notices, standards and clearances is a problem for big content publishers/owners as much as it is for small content publishers/owners. It is a problem waiting to be solved.

Competition

There are a variety of competing technologies for digital copyright protection, such as Cryptolopes and Digital Watermarks, that attempt to imbed or encrypt digital images and/or streaming audio and video files with marks that identify the owner. These watermarks can track whether the digital file has been legally licensed. This technology does not include the protection of text information, such as articles, unless the article is printed on a background image that includes a watermark. In the case of text, however, it is very easy to cut, copy and paste the text off the background, leaving the watermark behind.

There are a variety of clearinghouse agencies for the print and broadcast media, but none of them can be found online at the present time. The closest competitor, or perhaps collaborator in an effort like copyright, is the Copyright Clearance Center (CCC). They have a web site at <http://www.copyright.com>. This is a non-profit organization for paying members only. It facilitates copyright permissions for photocopies owned by its members. It is unclear whether CCC will make a foray into the Internet space.

Revenue Sources and Projections

Five year financial projections are currently being developed. The revenue potential for an Internet service such as icopyright is thought to be in excess of \$100 million per year. The service is expected to earn a transaction fee on millions of clearances and reprints processed each day. In addition to revenue from clearance transactions and reprints, revenue will come from digital mastering fees for streaming audio and video. There also exists the potential for substantial revenue from sponsorships.

If implemented as envisioned, icopyright.com would be one of the largest, most popular destinations on the Internet. The icopyright button could become the most prolific and widely-recognized icon in Cyberspace.

These user impressions are worth \$10 - \$30 per thousand (CPM) to national advertisers seeking to reach and influence online users.

Another source of revenue might be licensing fees from software developers and content publishers, in the form of a software development kit (SDK) that can be integrated into their products. Since all software in the future is expected to provide direct connections to the Internet, and many of these allow for the direct capture or manipulation of content (i.e., word-processing, DTP, Web page/site builders, graphics programs, etc.), building a copyright clearance component into their products would be a prudent step for most software developers and publishers.

The Barriers

At this stage there are two significant barriers to commercializing a service like icopyright. The first is the international implications for copyright clearances. The Internet is by default an international medium. The requirement to address copyright laws, clearances, currency and taxes as they relate to transaction processing -- and other regulatory and commerce variables from country-to-country -- is unknown at this time. Once overcome, however, there is an opportunity to set the direction for content handling on the Internet on a world-wide scope.

The second barrier is in quantifying, and providing for, the wide range of copyright policies and protections that may be demanded by millions of content owners. Getting people to trust a centralized source may take some time. Getting content owners and publishers to agree on standard mechanisms for clearance and re-licensing may be a large undertaking. Once overcome, however, icopyright has an opportunity to help define and implement standards and processes that protect the content owners, while reducing the pirating and misuse of digital content among the general public. Most importantly, it can help content publishers maximize the amount of money they make from their intellectual property.

Key Strategic and Tactical Components

1. Infrastructure Components

icopyright will require one or more web servers, co-location services, server software, and backbone connectivity. It may also require a virtual private network (VPN).

2. Technology Components

icopyright will require a relational database system, an e-commerce system for secure transactions, cgi forms handling, file transport system for print services and digital mastering, and possibly an ad server. icopyright will also require extended royalty reporting and payments system and various community-building tools. Some custom development and system integration will be necessary, however most of the technology can be licensed from existing sources.

3. Content Components

icopyright will require easy to navigate web pages, wizards, and fill-in-the-blank forms for submission inquiries; information on copyright laws and user rights and obligations; and co-branded links to authoritative sources. Web masters need to be able to auto-register with icopyright and add the icon to their pages through a do-it-yourself mechanism.

4. Strategic Partner Components

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icopyright will require wide bipartisan support from the private, public and non-profit sectors of the economy, on a world-wide basis. A coalition of strategic partners may include: Network Solutions (holders of all domain name registrations), Oracle or Sybase (database solution), Netscape or Microsoft (web browser/web server/merchant technology), W3 Consortium (embody the spirit of the Internet), and the U.S. Copyright Office (citizen rights and obligations).

In addition, the need to enroll several of the top content publishers on the Internet is paramount. These may include: AOL, Netscape, Yahoo, Microsoft, Time Warner, Disney, Ziff Davis, Excite, Lycos, CNN, and USA Today. A relationship with one or more of the large digital printing facilities will be required (Donnelley, Moore, Kinkos, Alpha Graphics). The ability to "affiliate" the existing re-print and permissions clearinghouse community should also be considered as part of the strategy to gain wide adoption quickly.

5. Marketing/Branding Components

icopyright will require a strong mark (brand), represented in the form of an icon, that can be used on ANY web page and in any other medium. It must be conspicuous, yet non-offensive to site designers and developers if it is to be widely adopted. The name icopyright must be free of all potential conflicts.

6. Management and Staffing Components

icopyright requires a strong e-commerce engineering team, web site design, development and maintenance team, business development team, marketing team, product management team, and intellectual property (legal) team. These teams can be comprised of employees and contractors.

Next Steps

Develop a comprehensive business plan for icopyright.

RELATED PROCEEDINGS APPENDIX

Appellants are not aware of any related appeals or interferences, as stated in the accompanying Appeal Brief.